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REMARKS

The Applicants request reconsideration of the rejection.

Claims 1, 4, and 8-13 are pending.

Claims 1, 4, and 8-11 were rejected under 35 U.S.C.

§103(a) as being unpatentable over Ito, US Patent Application Publication No. 2002/0144186 A1 (Ito) in view of Yada, et al., US 6,697,958 (Yada). The Applicants traverse, noting that Ito is not prima facie prior art to the present invention.

Ito was filed in the United States on May 21, 2002, which is after the Applicants' U.S filing date of November 17, 2000. Apparently, the Examiner determined Ito to be prior art on the basis of Ito claiming priority under 35 U.S.C. §120 to international (PCT) patent application no. PCT/JP99/06594, which was filed on November 25, 1999.

Ito does not enjoy its international filing date as a reference date under 35 U.S.C. §102(e), which it must in order to be a reference in combination with Yada under §103(a) as applied by the Examiner. Note Manual of Patent Examining Procedure (MPEP) §706.02(a), pertinent portions of which are reproduced below:

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As mentioned above, references based on international applications that were filed prior to November 29, 2000 are subject to the former (pre-AIPA) version of 35 U.S.C. 102(e) as set forth below.

*Former 35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.*

A person shall be entitled to a patent unless

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Revised 35 U.S.C. 102(e) has two separate clauses, namely, 35 U.S.C. 102(e)(1) for publications of patent applications and 35 U.S.C. 102(e)(2) for U.S. patents. 35 U.S.C. 102(e)(1), in combination with amended 35 U.S.C. 374, created a new category of prior art by providing prior art effect for certain publications of patent applications, including certain international applications, as of their effective United States filing dates (which will include certain international filing dates). Under revised 35 U.S.C. 102(e), an international filing date which is on or after November 29, 2000 is a United States filing date if the international application designated the United States and was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language. Therefore, the prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date (if all three conditions noted above are met) or an earlier U.S. filing date for which priority or benefit is properly claimed. Publication under PCT Article 21(2) may result from a request for early publication by an applicant of an international application or after the expiration of 18-months after

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the earliest claimed filing date in an international application. An applicant of an international application that has designated only the U.S. would continue to be required to request publication from WIPO as the reservation under PCT Article 64(4) continues to be in effect for such applicants. International applications, which: (1) were filed prior to November 29, 2000, or (2) did not designate the U.S., or (3) were not published in English under PCT Article 21(2) by WIPO, may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. 102(e). (underlining added)

Ito thus fails as a reference on at least two grounds. First, Ito is a published U.S. patent application, and thus not a "patent" as required by the pertinent version of §102(e). Second, Ito, being based on an international application filed before November 29, 2000, cannot be a reference based on its international filing date at all under the pertinent version of §102(e).

In addition, even under the revised version of §102(e), Ito would only be available as a reference if its international publication had been published in English by the World Intellectual Property Organization (WIPO). Ito, however, was published in Japanese.

Even if Ito were a proper reference, however, the rejection would still fail because the secondary reference to Yada does not show how to handle incompletely reproduced data


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resulting from failure of retry. Thus, the combination does not suggest the claimed invention.

In view of the foregoing amendments and remarks, the Applicants request reconsideration of the invention and allowance of the claims.

Respectfully submitted,

  
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Date: October 28, 2004